

## **REMARKS**

It is noted preliminarily, as will be clearly highlighted in Applicants' Appeal Brief, that the new rejection in the Office Action dated March 28, 2005, completely contradicts the Examiner's previous indication that all claims would be allowed when rewritten in independent format. Applicants had detrimentally relied upon this commitment and placed all claims into condition for allowance, including the expense of additional independent claims.

It is noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-9 and 11-33, all of the claims currently pending in the present Application now stand as rejected. More specifically, as best understood, claims 1, 22, 29, and 30 stand as rejected under 35 USC §103(a) as unpatentable over US Patent 6,405,192 to Brown et al. As best understood, claims 2-9 and 11-33 stand as rejected under 35 USC §103(a) as unpatentable over Brown, further in view of US Patent 6,070,176 to Downs et al.

These rejections are respectfully traversed in view of the following discussion.

### **I. THE CLAIMED INVENTION**

As described and claimed (e.g., by claim 1), the present invention is directed to a method of processing search results obtained in response to a user query. Document pointers returned by a search engine are provided to identify a source from which documents are available. Each of the document pointers includes a Uniform Resource Locator (URL).

At least two visual abstracts are generated for at least one of the documents, each visual abstract being a thumbnail image of a different size. A stream of data is formatted such that when said data is displayed on a display screen regarding the at least one of the documents, a smaller one of the visual abstracts appears adjacent to a corresponding search result.

An advantage of the present invention over the prior art is that a user can more easily determine relevance of the source document by seeing a thumbnail image of the document and

does not need to retrieve the document itself unless it seems sufficiently relevant, thereby saving time and network bandwidth.

## II. THE PRIOR ART REJECTIONS

### **The Rejection Based on Brown**

In the latest Office Action, the Examiner completely reverses his previous commitment that all claims would be allowable if rewritten in independent format. Applicants submit that the current rejection is deficient, as a matter of law, by reason of continuing to use the wrong standard of review, by failing to heed the plain meaning of the claim language, by failing to provide a reasonable motivation to modify, and by complete reliance on simple conclusory statements in the evaluation.

As best understood, the Examiner now alleges that Brown renders obvious claims 1, 22, 29, and 30. The Examiner is understood as alleging that Brown teaches all claim elements except that two thumbnail images, rather than one, are displayed.

However, Applicants submit that there are actually a number of key aspects of the present invention, defined by these claims, that are neither present in Brown nor would be obvious to one of ordinary skill in the art, given the contradictory teachings of Brown.

First, Applicants submit that the principle in Brown is entirely different from that required of the plain meaning of the language of these independent claims. The claims clearly require that the the document pointers, including a Uniform Resource Locator (URL), be “... returned by a search engine.” Applicants submit that, to one of ordinary skill in the art, this requirement is clearly not satisfied in the process underlying the presentation of thumbnail images, as shown in Figure 9 of Brown.

That is, as clearly described beginning at line 61 of column 9, this presentation of thumbnail images are not pages due to the search engine itself. Rather, these thumbnail images in Figure 9 are images of linked pages included on a page that the user has selected for viewing. This is an entirely different concept. That is, Applicants submit that, to one of ordinary skill in

the art, the presentation of the thumbnails in Brown results from the parsing of the page currently being displayed, not from the search engine results.

Although the search engine in Brown might be reasonably described as providing the link to the page that the user decides to display, it is the page that is selected by the user that provides these links that are then retrieved and presented in thumbnail images shown in Figure 9. The browser in Brown is able to use these links to retrieve the thumbnail images for Figure 9 without requiring another exercise of the search engine. Thus, this process does not satisfy the plain meaning of the claim language.

Hence, turning to the clear language of the claims in Brown there is no teaching or suggestion of: "... providing document pointers returned by a search engine to identify a source from which documents are available ...", as required by independent claim 1. The remaining independent claims have similar language.

Applicants further submit, because of this basic difference in principle of operation (e.g., the links being provided by a parsing operation by a browser of a selected page versus a search engine result), that Brown cannot even be used as the primary reference in a prior art evaluation of the present invention, as clearly stated in MPEP §2143.01: *"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."*

Second, Applicants again submit that this Examiner continues to use the wrong standard of review. For some inexplicable reason, this Examiner continuous to dilute the review standard as being that of merely placing on record a conclusory statement of hindsight. That is, the Examiner alleges that obviousness is present because "... A person having ordinary skill in the art would have readily recognized the desirability and advantages of ...."

Third, the Examiner concedes that Brown fails to use two thumbnail images. To overcome this basic deficiency, the Examiner then merely makes a conclusory statement that two images are well known in the art. Applicants submit that this analysis is an invocation of Official Notice and requests that the Examiner provide a reasonably combinable reference on record prior

to proceeding to Appeal, as required by *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and discussed in MPEP §2143.01 under its first major subheading.

Along this line, as clearly stated in a subsequent subheading under MPEP §2143.01: “FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NO SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS.”

Fourth, Applicants submit that the Examiner’s statement of the purported benefits of a second, larger thumbnail is both technically incorrect and legally irrelevant. The Examiner says: “This benefits the system by allowing users to view a larger abstract when the smaller one is not sufficient for determining the validity of the result.”

Applicants submit that “validity of the result” is not at issue in *Brown*. The links on the page that has been selected by the user are not subject to any credible question of validity, since the thumbnail returned for presentation will be whatever page is located at the URL underlying the link on the selected page. There is no reason to doubt its validity.

Fifth, Applicants submit that, to one of ordinary skill in the art, *Brown* actually teaches against providing a second, larger thumbnail image, since this reference clearly teaches an alternate method of providing an indication to the user of the relevance of the thumbnail images shown in Figure 9. That is, as shown in Figures 9-11 and described beginning at line 61 of column 9, various methods are demonstrated to permit the user to recognize how each of the linked pages might be of further interest. There is no suggestion whatsoever in these alternate indications that a larger thumbnail might be of use. Indeed, Applicants submit that the more realistic method in *Brown* would be to simply retrieve the full page of any linked pages that the user thought might be of interest, given the clues presented by the various methods associated with the thumbnail images.

Sixth, Applicants submit that the purpose of *Brown* clearly demonstrates that it addresses an entirely different aspect of searching from that addressed by the present invention. One exemplary key purpose of the present invention is that of allowing the user to quickly evaluate the results of the search engine by presenting a smaller thumbnail image associated with the

listing of the results and making available a second, larger thumbnail image for a quick evaluation of selected ones of the results.

Applicants submit that the purpose of Brown is entirely different, since its technique is intended to allow the user to recognize whether linked pages on a selected page might be of interest, as indicated by the various methods described in that reference. This purpose is entirely different from attempting to expedite the user's evaluation of the initial results of the search engine. That is, Brown attempts to allow the user to find additional web pages from those URLs included in the initial search engine results, as based on having been included in pages selected by the user. Brown even allows the user to continue to sequentially explore deeper levels of linked pages by checking linked pages included on selected ones of those linked pages, etc.

Applicants submit, therefore, that the principle of operation in Brown is distinctly different from that of the present invention because it has an entirely different purpose from that of expediting review of the initial search engine results.

Because of this basic difference in purpose and principle of operation between Brown and the present invention defined by the independent claims, Applicants submit that the present invention is clearly patentable over Brown.

### **The Rejection Based on Combining Brown and Downs**

The Examiner concedes that Brown fails to teach or suggest a number of aspects defined by various dependent claims. To overcome these deficiencies, the Examiner relies upon Downs.

Applicants submit that, to one of ordinary skill in the art, Downs would also not be a reasonably proper reference to use in the prior art evaluation of the present invention, since its use of an abstract "form" to represent each source document clearly teaches against the thumbnail images used in either Brown or in the present invention.

That is, although the Examiner attempts to use Downs as the basis to overcome the deficiency that Brown fails to enhance features on the thumbnail images, this analysis completely overlooks the fact that Downs is not enhancing information to become more visible in a thumbnail image. Rather, Downs is actually adding information to the generic abstract forms that it uses to construct its three-dimensional distance representation for the search results.

Applicants submit, that adding information to an abstract form is an entirely different principle of operation from that of enhancing information already present in a page to be reduced into a thumbnail image. Neither Downs nor Brown suggests any enhancing of information on that page before transforming the page into a thumbnail image. Applicants submit that taking words out-of-context, as is done in the rejection currently of record, does not permit the Examiner to overlook this basic difference in principle of operation, and that this basic difference in principle of operation precludes Brown from being modified by Downs.

Applicants further submit that, relative to the Examiner's rationale that is essentially repeated throughout the rejection (e.g., "Without a title or other larger identifying marking, the search result may be rendered useless to the requestor."), Brown uses an entirely different set of techniques to convey information on the desirability of each of the linked pages shown in Figure 9.

It is not reasonable to characterize that the linked page representation in Figure 9 of Brown is "rendered useless" because a title is missing or too small to read easily, as alleged by the Examiner. Brown simply provides the information that it considers important for its purpose in a different format from that upon which the Examiner relies.

In addition to the basic impropriety of modifying Brown with Downs, as discussed above, Applicants bring the following deficiencies of the rejection currently of record. Applicants request that the Examiner provide some reasonable response on record prior to proceeding to Appeal.

Relative to the rejection in paragraph 6 on page 4 of the Office Action for claim 2, Applicants submit that, to one of ordinary skill in the art, "... manipulating said document so as to enhance a visibility of at least a portion of said document" is not taught or suggested in either Downs or Brown. Downs merely adds a title to a generic abstract form that represents the document in its mapping representation.

Relative to the rejection in paragraph 7 on page 5 of the Office Action for claims 3, 4, and 18, the Examiner seems to confirm that "filtering" is intended in the evaluation as directed toward the technique in Downs in which each documents is reduced into a generic abstract for (e.g., the Examiner states: "*Please note that images are filtered out in the reference.*").

Applicants submit that, to one of ordinary skill in the art, this interpretation fails to satisfy the plain meaning of the claim language of claims 2 and 3, in which the filtering is involved in the manipulation that enhances a visibility of at least a portion of the document, since filtering out images from the documents to provide the generic abstract forms of Downs does not enhance visibility of a portion of the document. Rather, this type of filtering of images reduces visibility of that portion of the document.

Relative to the rejection in paragraph 8 on page 6 of the Office Action for claims 5-9, 12-16, 25-27, 32, and 33, Applicants submit that the rejection fails to address the plain meaning of the claim language in the context of the claim and that the Examiner has invoked Office Notice. There is no suggestion in Brown to provide a larger image and Applicants request that the Examiner provide a reference prior to proceeding to Appeal that is reasonably combinable in the claimed context.

Relative to the rejection in paragraph 9 on page 7 of the Office Action for claim 11, Applicants submit that the Examiner's implied characterization of Brown is technically incorrect. As explained above in the discussion above for claim 1, the document pointers from the search engine in Brown are not used in gathering the information for the thumbnail representation shown in Figures 9-11. These thumbnails are resultant from the links on a page selected by the user. Moreover, as explained elsewhere above, the process of adding titles to the generic forms of Downs is entirely different in concept from enhancing information in the thumbnail images of Figure 9 of Brown. Nor does either Brown or Downs suggest using a second, larger thumbnail image. Applicants submit that the Examiner has invoked Official Notice and request that a reasonably combinable reference be placed on record.

Relative to the rejection in paragraph 10 beginning on page 7 of the Office Action for claim 17, Applicants submit that the adding of a title to the generic forms of Downs does not satisfy the plain meaning of the claim language for the step "determining whether a portion of a source document should be enhanced for visibility relative to another portion."

Relative to the rejection in paragraph 11 beginning on page 9 of the Office Action for claims 19-21 and 24, Applicants submit that the addition of a title to the generic form of Downs fails to satisfy the plain meaning of the claim language.

### III. FORMAL MATTERS AND CONCLUSION

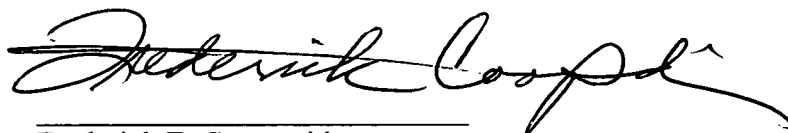
In view of the foregoing, Applicant submits that claims 1-9 and 11-33, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: 6/28/05



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